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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,331	06/26/2003	David W. Deaton	2222.219000V	7922

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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SHAH, AMEE A

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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03/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/609,331	<b>Applicant(s)</b> DEATON ET AL.	
	<b>Examiner</b> Amea A. Shah	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20,96 and 97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20,96 and 97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-20, 96 and 97 are pending in this action.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 7, 2008, has been entered.

#### ***Examiner Note***

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### ***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

**Claims 1-6, 11, 16, 17, 96 and 97 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl et al., US 5,873,069, cited by Applicant (hereafter referred to as “Reuhl”) in view of Christianson et al., 6,102,969 (hereafter referred to as “Christianson”).**

Referring to claim 1. Reuhl teaches a method for use in marketing, comprising:

- detecting, at a remote computer, product purchase information of a plurality of stores, the product purchase information including at least purchase price information, the remote computer located remote from the stores (col. 3, lines 18-28, col. 8, lines 64-68 and col. 10, lines 15-32 – note that the product purchase information is detected “enterprise-wide (e.g. a retailer with many locations in many market areas),” as well as from competitors, thereby comprising a plurality of retail stores);

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- receiving, at the remote computer, a shopping list of a customer, the shopping list including at least one item (col. 10, lines 54-61 – note the shopping list of at least one item is the entering of product identification code by the user); and
- in response to receiving the shopping list, initiating communication to the customer via the remote computer, of purchase price information associated with the at least one item from the shopping list for the plurality of stores (Fig. 8 and col. 11, lines 11-23 – note the price information is displayed as the result of the search).

While Reuhl teaches detecting product purchase information including price information by searching a database once prices are inputted (col. 16, lines 5-27), it does not specifically show detecting the purchase price information from a plurality of different retailers from points-of-sale associated with the respective retailers. However, Christianson, in the same field of endeavor and/or pertaining to the same issue, teaches the use of “shopbots” for detecting product purchase information, including price information, of a plurality of different retailers from points-of-sale associated with the respective retailers (Fig. 2A and col. 6, lines 14-42 - note that the “shopbot,” similar to a web-crawler, detects price information from various retailer websites, i.e. points-of-sale, by querying and receiving responses through a remote computer).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of a shopbot for detecting price information from a plurality of retailers from points-of-sale associated with the retailers, as taught by Christianson, with the known elements of receiving price information, received a shopping list and communicating price information associated with the list, as taught by Reuhl, as each element would have performed the same function in combination as it did separately.

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One ordinary skill in the art would have recognized that the combination of Reuhl and Christianson would yield the predictable results of retrieving relevant data as quickly as possible, as suggested by Christianson (col. 2, lines 53-66).

Referring to claim 2. Reuhl and Christianson further teach the method of claim 1 wherein initiating communication comprises transmitting an electronic mail message for receipt by the customer (Reuhl, col. 11, lines 11-23 – note the electronic mail message is the display presented to the customer).

Referring to claim 3. Reuhl and Christianson further teach the method of claim 1 wherein the detecting of product purchase information of a plurality of retailers occurs on a substantially real-time basis (Christianson, col. 2, lines 61-66 - note that the bit works fast, i.e. on a substantially real-time basis). One ordinary skill in the art would have recognized that the combination of Reuhl and Christianson would yield the predictable results of retrieving relevant data as quickly as possible, as suggested by Christianson (col. 2, lines 53-66).

Referring to claim 4. Reuhl and Christianson further teach the method of claim 1 wherein receiving a shopping list of a customer comprises receiving an electronic mail message including the at least one item (Reuhl, col. 11, lines 2-10 – note the message includes the product identification of the item).

Referring to claims 5 and 6. Reuhl and Christianson further teach the method of claim 1 wherein receiving a shopping list of a customer comprises receiving information from the

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customer over the Internet by receiving information inputted into a web page associated with the remote computer (Christianson, Fig. 2A and col. 6, lines 7-13). One ordinary skill in the art would have recognized that the combination of Reuhl and Christianson would yield the predictable results of retrieving relevant data as quickly as possible, as suggested by Christianson (col. 2, lines 53-66).

Referring to claim 11. Reuhl and Christianson also teach the method of claim 1 further comprising initiating, by the remote computer, communication of an incentive associated with the at least one item to the customer in response to receiving the shopping list (Reuhl, col. 11, lines 11-24 – note the incentive is the value added promotion being offered).

Referring to claim 16. Reuhl and Christianson also teach the method of claim 11 further comprising comparing, by the computer, the price of the at least one item at a first retailer of the plurality of retailers to the lowest price at which the at least one item was purchased from the first retailer within a predetermine time period, the lowest price determined from the product purchase information, and wherein the incentive comprises a discount sufficient to lower the effective price at the first retail store on the at least one item to match or beat the lowest price (Reuhl, Fig. 10, col. 10, lines 27-31 and col. 12, lines 8-27).

Referring to claim 17. Reuhl and Christianson further teach the method of claim 16 wherein the predetermined time period is approximately one hour from the receipt of the

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shopping list (Reuhl, col. 10, lines 27-31 – note that with the predetermined price frequencies, a price request, i.e. shopping list, may be received close to one hour from the pricing time).

Referring to claims 96 and 97. All of the limitations in apparatus claims 96 and 97 are closely parallel to the limitations of method claim 1, analyzed above and are rejected on the same bases.

**Claims 7-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl and Christianson in view of Herz et al., US 2001/0014868 (hereafter referred to as “Herz”).**

Referring to claim 7. Reuhl and Christianson teach the method of claim 1, as discussed above, but do not specifically disclose storing product purchase information from the plurality of retail stores in association with customer identification numbers. Herz, in the same field of endeavor and/or pertaining to the same issue, discloses a method and system for customizing prices and promotions tailored to individual shoppers or types of shoppers including storing product purchase information from the plurality of retail stores in association with customer identification numbers (Fig. 1 and ¶¶0024 and 0029-0035 – note the customer identification number is the identity of the shopper).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of storing product purchase information from the plurality of retail stores in association with customer identification numbers, as taught by Herz, with the known elements of detecting prices, receiving a list and displaying prices relating to the list, as taught by Reuhl and Christianson, as each element would have performed



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the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Reuhl, Christianson and Herz would yield the predictable results of allowing for the tracking of product purchase information for each identified customer or type of customer, which may then be used for further marketing analysis and/or in providing more targeted offers reducing costs, improving accuracy and saving time, as suggested by Herz (¶0037).

Referring to claims 8-10. Reuhl, Christianson and Herz also teach the method of claim 7 further comprising transmitting to the customer a proposed shopping list prior to receiving the shopping list including at least one item and products previously purchased by the customer in the customer's most recent shopping transaction with one of the retail store wherein the proposed shopping list comprises products previously purchased by the customer (Herz, ¶¶0262, 0298-0303 and 0315). One ordinary skill in the art would have recognized that the combination of Reuhl, Christianson and Herz would yield the predictable results of maximizing profit by selecting promotions, including suggested shopping lists, based on purchase history so as to increase the likelihood of a customer purchase, as suggested by Herz (¶¶0262 and 0298).

**Claims 12-15 and 18-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl in view of Christianson and further in view of Official Notice.**

Referring to claims 12, 13 and 18-20. Reuhl and Christianson teach the method of claim 11, as discussed above, but does not specifically teach the incentive comprising a discount on the at least one item, or a discount on a product competitive with the at least one item. However,

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official notice is taken that using such types of incentives as a discount on the at least one item and a discount on a product competitive with the at least one item was old and well known in the art at the time of the invention. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have incorporated such incentives into the incentives provided in the method of Reuhl. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would allow for the customer to ensure that the prices are the most recent and reflect the latest changes made by the stores, thus improving the accuracy of the method and increasing customer satisfaction. Furthermore, the exact type of incentive is nonfunctional descriptive material that is not functionally involved in the communicating step recited. The communicating of an incentive would be performed in the same manner regardless of whether the incentive was a rebate, a discount or a coupon. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Referring to claim 14. Reuhl, Christianson and Official Notice teach the method of claim 13 and further comprising comparing, by the computer, the price of the at least one item at a first one of the plurality of retail stores to the price of the competitive item at the first retail store, the price of the at least one item and the competitive item at the first retail store determined from the product purchase information (Reuhl, Fig. 10 and col. 12, lines 8-27), and wherein the incentive comprises a discount sufficient to lower the effective price on the competitive item to

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match or beat the price of the at least one item (Reuhl, Fig. 10, col. 7, lines 17-21 and col. 11, line 64 through col. 12, line 27).

Referring to claim 15. Reuhl, Christianson and Official Notice further teach the method of claim 13 wherein the price of the competitive item comprises the price at which the competitive item was purchased within an hour of the receipt of the shopping list (Reuhl, col. 10, lines 27-31 – note that the predetermined price frequencies may be within one hour of the receipt of the list).

#### ***Response to Amendment***

Applicant's amendment, filed February 7, 2008, has been entered. Claims 1, 10, 15, 16, 96 and 97 have been amended.

#### ***Response to Arguments***

Applicant's arguments filed February 7, 2008, have been fully considered but they are not persuasive. Applicant's arguments that Reuhl does not teach detecting prices (Remarks, pages 9, 11 and 12) are an attack against the references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner has shown that Reuhl with Christianson's use of shopbots teach the limitations of the claims as recited.

In response to applicant's argument that Christianson does not teach detecting at a remote computer product purchase information that includes purchase price information (Remarks, pages 10-12), the Examiner disagrees. Christianson teaches using a shopbot to detect the price at which a product can be purchased, i.e. purchase price information, from a variety of different retailers (e.g. col. 6, lines 14-42).

In response to applicant's traversal of the office notice of using such incentives as a discount on the at least one item and a discount on a product competitive with the at least one item (Remarks, pages 16-18), the examiner would point out the applicant has not provided any evidence or showing contrary to examiner's observation of official notice; applicant merely makes a conclusory statement that it was not old and well known to have such incentives. However, in response to applicant's request for providing an evidence, the examiner refers to Williams, US 6,278,979, that teaches a method for creating incentives in response to a transaction wherein the incentives may be discount coupons on a particular product or a product in a related category, i.e. a competitive product (see, e.g., Abstract and col. 7, lines 35-42). This reference is provided only as an evidence for the Official Notice observed by the examiner that such incentives may comprise discounts on an item or competitive and not as a new reference.

### ***Conclusion***

All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even

though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is (571)272-8116. The examiner can normally be reached on Flex-time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

February 28, 2008

/Yogesh C Garg/

Primary Examiner, Art Unit 3625